

Appl. No.: 10/771,805
Amdt. Dated: 12/05/2008
Off. Act. Dated: 09/08/2008

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested in view of the discussion presented herein.

1. Rejection of Claims 1-10 and 17-28 under 35 U.S.C. § 102(e).

Claims 1-10 and 17-28 were rejected herein under 35 U.S.C. § 102(e) as being anticipated by Lamkin (U.S. Publ. No. 2006/0159109). Claims 1, 10, 17, and 24-28 are the independent claims within the above group of claims.

After carefully considering the grounds for rejection and response to the prior arguments the Applicant responds as follows.

(a) Claims 1, 10, 17-18, and 24-28.

In support of the rejection it is put forth that Lamkin teaches all aspects recited in the above group of claims.

However, a number of shortcomings are found in this reference, as discussed below.

First, in regard to the limitation about *“receiving new content within a request from a user”*, this has been amended herein to even more clearly recite *“receiving new content within a request submitted by a user”*. The rejection asserts that the provisional application 60/531,565 provides support for this aspect, and a section of text is cited (page 42 of 99, 1st and 2nd paragraphs). In that section of text, which discusses a content manager which determines playback criteria, the only reference to new content is the following: *“The content manager uses the collection name service module to request new content for playback. The content manager coordinates all of the rules and search criteria used to find new content.”* A number of intractable shortcomings are readily seen in the above text. (A) The text speaks of operations of the content manager; there is nothing in relation to a request from the user, and more particularly, no new content described WITHIN a request submitted by the user. (B) The relied-upon text is not about content being submitted at all but briefly mentions that the content

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manager coordinates search criteria for “*finding new content.*”

It is then asserted that another section of text (page 58 of 99, 1st paragraph), provides additional teachings, wherein “*the new content acquisition agent*” is taught which “*acts as a broker on behalf of a specific user to acquire new content collections and the associated access rights for those collections.*” Again, it is readily seen that there is no interconnection with “*receiving new content within a request submitted by a user*”, as required by the claim limitation. Agents are pieces of software which perform actions on behalf of a user, also commonly referred to in many fields as “bots”. In this text, it is clearly seen that this agent is working for a user trying to acquire content and access rights for that content. Furthermore, it states “acquiring new content collections”, which even further teaches away from the claimed invention. A specific content element within a request by a user is being equated with a piece of software which searches for content collections, thus ignoring the plain text of the recited claim.

Nothing but generalizations about new content and content collections are asserted in support of the rejection. The claim is very specific about the relationship of the new content and request of the user. Other elements of the claim then bring even greater distinctions with regard to performing the request and creating a new content record.

The second major area of intractable shortcomings of the rejection is in regard to how the content records, specifically the fields therein, are automatically completed for the “*new content within a request submitted by a user*”, as received.

This next element recites: “*automatically completing fields within said new content record based on information contained in the specific content as well as information about the presence of duplicate or related content which is available across the multiple devices.*” Furthermore, the claim has been clarified to an even greater extent, now reciting: “*wherein new content without a record is compared with existing content having a corresponding record, and if the new content is at least similar to existing content, then the records from the existing content are utilized in completing the*

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fields of the new content.”

In support of the rejection for the above, the rejection directs attention to paragraph [0140] of Lamkin, which is shown below.

[0140] Similarly, in step 954, the process determines whether the statuses of copies of the content are to be changed. When the status is to be changed, step 956 is entered where the status is changed to appropriate copies of the content. In step 960 the process determines whether content has been changed or updated. When the content has been changed, step 962 is entered where it is determined whether to change or update copies on the network. When content on the network is to be updated or changed, step 964 is entered and appropriate content is updated or changed. This determination can include comparing the changed content to a base content or content on the network, identifying changes and implementing similar changes over the network.

The only thing supported by paragraph [0140] is that the status of different content can be changed. No specifics are provided about any means of “*automatically completing fields within said new content record*”, and more specifically as the claim continues of “*based on information contained in the specific content as well as information about the presence of duplicate or related content which is available across the multiple devices.*” It should also be noted that paragraph [0140] is from the later Lamkin application, and it is unknown if that level of discussion is even provided in the actual provisional application, which is the actual prior art. The additional “wherein” clause of amended Claim 1 then further discusses this aspect of how the fields are automatically completed, and no teaching has been shown from the Lamkin reference for this aspect.

Support for an anticipation rejection requires that every claim element must be taught or inherent in a single prior art reference, Manual of Patent Examining Procedure (MPEP) §706.02a. The above claims at issue are thus not anticipated by the relied-upon Lamkin reference.

For a reference to anticipate in terms of §102, every element of the claimed invention must be identically shown in a single reference. Diversitech Corp. v. Century Steps, Inc. 850 F.2d 675, 677, 7 USPQ2d 1315, 1317 (Fed.Cir. 1988). These elements must be arranged as in the claim under review,

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Linderman Maschinenfabrik v. American Hoist & Derrick Co. 730 F.2d 1452, 1458, 221 USPQ 481,485 (Fed.Cir. 1984).

Anticipation requires the presence, in a single prior art disclosure, of all elements of a claimed invention arranged as in the claim. A prior art disclosure that "almost" meets that standard may render the claim invalid under §103; it does not "anticipate." Anticipation is not shown by a prior art disclosure which is only "substantially the same" as the claimed invention. Jamesbury Corp. v. Litton Industrial Products, Inc. 756 F.2d 1556, 225 USPQ 253 (Fed.Cir. 1985).

There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. [Emphasis added.] Scripps Clinic & Research Foundation v. Genentech 927 F.2d 1565, 18 USPQ 2d 1001 (Fed.Cir. 1991).

The elements of the relied-upon reference are manifestly not "*identically shown*" in the relied-upon reference. What is found in support of the rejection are generalizations based on similar concepts. However, concepts and ideas are not patentable; patent protection is only granted for specific embodiments put forth for carrying out concepts and ideas. Therefore, it is immaterial if the embodiment is directed toward a similar "idea" or "inventive concept". For instance, there exist numerous multiblade shaving razors on the market, each having a patent on its own patentably distinct elements, while being directed toward the same or similar inventive concepts.

Further support for this argument is put forth by the Administrative Patent Judge in Appeal No. 96-0651 of Application No. 08/087,164 as heard February 11, 1999.

Merely because two systems perform the same or a similar function does not, per se, make those systems patentably indistinct. For example, a quill and ink, a ballpoint pen and an electronic word processor may all perform the same function, i.e., the writing of a document, but, clearly, they do not perform the same function in the same manner.

Applicant also respectfully notes that according to the MPEP, it is not permissible to ignore the plain language of the claim in deference to postulating broad generalizations about what seems similar in the prior art, for example as found in MPEP

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Toro Co. v. White Consol. Indus., Inc., 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999)("[W]ords in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning.").

Applicant also must respectfully, but strongly, object to the manner in which all of the independent claims are treated in the rejection as if they were a single claim. Each claim is entitled to examination on the basis of the specific language and structure of the claim. Although examination of a single independent claim is expeditious on the part of the Examiner, this improper practice ignores the very specific teachings recited in the other independent claims, in particular, in Claims 10, 17, 24, 25, 26, 27, and 28. Some of these claims contain almost a full page of limitation language that is being improperly subsumed by the rejection of the broadest claim, in particular Claim 1.

Therefore, the Applicant respectfully asserts the Lamkin reference does not anticipate the claims of the instant application, and respectfully requests that the rejection of Claims 1, 10, 17, and 24-27, and the claims that depend therefrom, be withdrawn with the instant application allowed to issue.

(b) Claims 2-9 and 19-23. Claims 2-9 and 19-23 depend from independent parent claims whose patentability has been elucidated above; these claims should be considered *a fortiori* allowable. In addition, a number of these claims recite elements having additional patentable distinctions over the cited references, which appear rejected on the basis of undue generalizations of claim elements with regard to a view of the cited Lamkin reference.

Therefore, Applicant respectfully requests that the rejection of Claims 2-9 and 19-23 be withdrawn and the instant application allowed to issue.

2. Claims 1-10 and 17-28 are nonobvious.

Nor would the subject matter of Claims 1-10 and 17-28 be obvious to a person having ordinary skill in the art in view of Lamkin, singly or in combination with what is known to one of ordinary skill in the art. The reference neither suggests, teaches nor

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provides a motivation for “*receiving new content within a request submitted by a user*” and its associated treatment, including “*automatically completing fields within said new content record based on information contained in the specific content as well as information about the presence of duplicate or related content which is available across the multiple devices.*” Nor does the reference provide any structures related to this, or which identify a need for such a structure. Nor is there any suggestion, teaching or motivation which could be derived from that reference which would cause a person having ordinary skill in the art to so modify other material to accomplish the aspects recited in the claims of the instant application.

Therefore, since there is no need for a these aspects identified in the cited reference, and further, since there is no suggestion, teaching or motivation which can be found in that reference from which a person having ordinary skill in the art would find it obvious to modify the Lamkin therein to correspond to that described in the Applicant's claims, Claims 1-10 and 17-28 recite structure which is patentable over the cited references for purposes of 35 U.S.C. § 103.

3. Amendment of Claim 1.

Claim 1. Independent Claim 1 has been amended toward reciting with additional particularity, aspects of the invention. In the fourth claim element, the “*fields within*” the content record are described, which for example is supported in the specification as recited on page 9, line 19. In addition the new content “*submitted by a user*” is recited in the claim, which for example is supported in the specification as recited on page 10, line 5. Still further, a new wherein clause is included as “*wherein new content without a record is compared with existing content having a corresponding record, and if the new content is at least similar to existing content, then the records from the existing content are utilized in completing the fields of the new content*”, which is directed at the previous element, and which is taken almost verbatim from the specification as recited on page 14, lines 16-20.

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4. Amendments Made Without Prejudice or Estoppel.

Notwithstanding the amendments made and accompanying traversing remarks provided above, Applicant has made these amendments in order to recite Claim 1 with increased particularity without materially changing the scope or object of the claims. These amendments have been made without any prejudice, waiver, or estoppel, and without forfeiture or dedication to the public, with respect to the original subject matter of the claims as originally filed or in their form immediately preceding these amendments. Applicant reserves the right to pursue the original scope of these claims in the future, such as through continuation practice, for example.

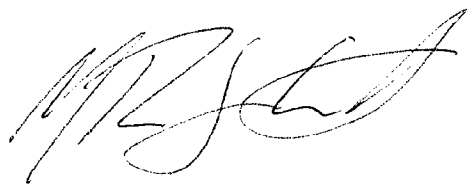
5. Conclusion.

Based on the foregoing, the Applicant respectfully requests that the various grounds for rejection in the Office Action be withdrawn and that a Notice of Allowance be issued for Claims 1-10 and 17-28.

In the event any further matters remain at issue with respect to the present application, Applicant respectfully requests that the Examiner please contact the undersigned below at the telephone number indicated in order to discuss such matter prior to the next action on the merits of this application.

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Respectfully submitted,



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